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## **REMARKS**

### **1. Status of the Claims**

Claims 1 – 13, 15 – 34, and 37 – 48 are pending; claims 14, 35, and 36 having previously been cancelled.

### **2. Rejection of Claims 3, 4, 24, 25 and 1, 7, 8, 28 and 29 under 35 USC §112, second paragraph**

With regard to the repeated rejections of claims 3, 4, 24 and 25 for failing to state “thresholds or other measures,” the undersigned notes that the claims recite the average for use as a datum, and that this would be readily understood by one of ordinary skill in the art.

Claims 1, 7, 8, 28 and 29 stand rejected for indefiniteness on grounds set forth in the previous office action. In particular, the examiner objected to the language “having a sufficiently high ranking” in claim 1; the phrase “an evaluation of the uniqueness of the opportunity” in claims 7 and 28; and “the criteria include an evaluation of the advantages of the business opportunity over other business opportunities” in claims 8 and 29. These claims have been amended to obviate these rejections and are believed to meet the requirements of 35 USC §112.

### **4. Rejection of Claims 1-13, 15-34, and 37-48 under 35 USC §103(a)**

Claims 1-13, 15 – 20, 22-34, 37-41 and 43-48 stand rejected under 35 USC §103(a) as being unpatentable over Themescape in view of Karszes. Claims 21 and 42 stand rejected under 35 USC §103(a) as being unpatentable over Themescape and Karszes. The Applicants respectfully traverse this rejection and its supporting remarks.

The present invention is directed to the task of providing decision makers with the means for more dispassionately evaluating business opportunities. Decisions based on lone personal reckoning, even when framed with a checklist of “to do” suggestions, are still fundamentally personal in nature and thus fraught with error, are opaque, and otherwise not reproducible (page 2 of the specification). To avoid such errors and to provide an objective means of reaching a decision that makes the process less random

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and unpredictable, the claimed invention provides a set of steps for minimizing the errors inherent in known decision making processes. In particular, the claims recite the steps of:

1. identifying a first set of opportunities;
2. utilizing a group of people to analyze these opportunities to generate data that is processed via a computer. From this a high scoring subset is used to define a second set.
3. further analyzing this second set with usability/appropriability tool.
4. providing the data so analyzed in a usable form to decision makers.

Note that this entails a mix of players, human and machine, each doing what it can do best. While a machine may be employed to identify the first set of opportunities, in the second step further evaluations are conducted by teams of human beings so that the result is more reproducible and less reflective of the bias of an individual:

... a small group of people (e.g. ten) rank each of these technologies via a scoring tool. While the scores are provided by individuals and thus reflect their individual biases, in the aggregate, subjected to statistical analysis via a computer algorithm, they provide a more objective measure of the merits of the technology ( or other business opportunity) under study, as individual biases become subsume in the group. (Page 3, 3<sup>rd</sup> paragraph of the specification.)

In other steps, a single individual may be employed for subsequent detailed analysis of a specific opportunity, generating a further score using the usability/appropriability tools provided.

Neither Themescape nor Karszes provide any teaching whatsoever for such a mix of machine and human decision making. Instead, Themescape is directed solely to the task of arranging data in a graphical manner that is suitable for the user. There is nothing collaborative about this use of data set forth in the reference. Karszes offers up some suggestions for how a dairy farmer, working alone on his dairy farm, can come to some decision on how best to raise and milk cows. Alone or taken together, these references teach at most a means for gathering some data, arranging it in a visually useful manner, and then having a single person use some criteria (provided by Karszes in the context of a dairy farm) to decide which are worth pursuing. In the end, the decision so arrived at will reflect the biases of the individual making it, directly in opposition to the aims of the

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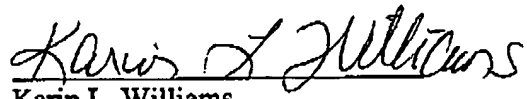
present invention and the method by which those aims are advanced, as set forth in the claims.

For at least the above reasons, it is respectfully submitted that claims are patentable over Themescape and Karszes and should be allowed.

Applicants submit that the claims of the present invention are in condition for allowance, early notification of which is earnestly solicited. Should the Examiner be of the view that an interview would expedite consideration of this Amendment or of the application at large, request is made that the Examiner telephone the Applicant's attorney at (908) 518-7700 to resolve any outstanding issues.

The Office is authorized any required fees to deposit account number 50-1047.

Respectfully submitted,

  
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